

REMARKS

In response to the Office Action dated October 20, 2004, Applicant respectfully requests reconsideration based on the above claim amendments and the following remarks. In the Office Action, claim 9 was rejected under 35 U.S.C. § 112, paras. 1 and 2 as failing to comply with the enablement requirement and for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Further, claims 1-3, 6, 8-11, and 14-20 were rejected under 35 U.S.C. § 102(b) as being anticipated by Ensley, U.S. Patent No. 3,166,810 (hereinafter "Ensley"). Additionally, claim 4 was rejected 35 U.S.C. § 103(a) as being unpatentable over Ensley. Furthermore, claims 5, 7, and 12-13 were objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Applicant submits that the claims 1-20 as initially presented were in acceptable form. Independent claims 1, 14, and 18 as well as dependent claims 5-6, 8-10, 12-13, and 20 have been amended to more particularly point out and distinctly claim the invention. Applicant further submits that the claims as filed were patentable over the prior art of record, and that the amendments herein are for purposes of clarifying the claims and/or for expediting allowance of the claims, and not for reasons related to patentability. Reconsideration is respectfully requested. Applicant respectfully traverses the rejections as follows.

Regarding the 35 U.S.C. § 112, paras. 1 and 2 rejections, the Office action rejected claim 9 alleging that it was indefinite. The Office action stated, "[c]laim 9 is indefinite because tape is being claimed as part of the invention and tape is not even disclosed as part of the invention. Tape is not shown as part of the invention as well." Office action, pg. 2, sec. 1a of 35 U.S.C. § 112, paras. 1 and 2. Applicant disagrees that claim 9 is indefinite, and submits that

the use of tape as recited in claim 9 is supported in the specification at page 9, lines 1-2.

Nevertheless, to expedite prosecution, claim 9 has been amended. Applicant respectfully submits that claim 9 meets the requirements of 35 U.S.C. § 112.

Turning to the 35 U.S.C. § 102(b) rejections, anticipation under 35 U.S.C. § 102(b) requires the disclosure in a single prior art reference of each and every element of the claim under consideration, and each element must be arranged as in the claim. Ensley does not teach or suggest, as in independent claim 1, a plurality of sequentially interconnected retainer portions each having a one-way locking passage therethrough adapted to retain the line.

Rather, Ensley is directed to utilizing “[a] plurality of wire-receiving bores 19 . . . extend parallel to the cylindrical axis 20 of the body 7 and are equally radially and equally circumferentially spaced about the axis 7.” Ensley, col. 2, lines 30-35. Indeed, if anything, Ensley *teaches away* from the use of sequentially interconnected retainer portions as Ensley discloses plurality of co-located wire-receiving bores. The use of sequentially interconnected retainer portions is far different from using co-located wire-receiving bores.

For at least the above reasons, Ensley fails to meet the requirements for supporting a 35 U.S.C. § 102(b) rejection of these claims, and applicants respectfully request reconsideration and withdrawal of the rejections of claim 1 based on Ensley. Similarly, Ensley does not teach or suggest the limitations present in claims 2-3, 6, and 8-11 when analyzed in light of the use of sequentially interconnected retainer portions. Therefore, claim 1 and the claims that depend thereon are patentable over the cited art.

Turning to the rejection of independent claim 14 of the present invention, Ensley does not teach or suggest attachment means for sequentially connecting the retaining means to a fish tape.

Rather, Ensley is directed to utilizing “[a] plurality of wire-receiving bores 19 . . . extend parallel to the cylindrical axis 20 of the body 7 and are equally radially and equally circumferentially spaced about the axis 7.” Ensley, col. 2, lines 30-35. For at least the above reasons, Ensley fails to meet the requirements for supporting a 35 U.S.C. §102(b) rejection of these claims, and applicants respectfully request reconsideration and withdrawal of the rejections of claim 14 based on Ensley. Similarly, Ensley does not teach or suggest the limitations present in claims 15-17 when analyzed in light of the use of means for sequentially connecting the retaining means to a fish tape. Therefore, claim 14 and the claims that depend thereon are patentable over the cited art.

Turning to the rejection of independent claim 18 of the present invention, Ensley does not teach or suggest pushing the line through a one-way locking passage housed in a sequentially interconnected retainer, attaching an attachment portion of the sequentially interconnected retainer to an end of a fish tape, and pulling the fish tape through the raceway. Rather, Ensley is directed to utilizing “[a] plurality of wire-receiving bores 19 . . . extend parallel to the cylindrical axis 20 of the body 7 and are equally radially and equally circumferentially spaced about the axis 7.” Ensley, col. 2, lines 30-35. For at least the above reasons, Ensley fails to meet the requirements for supporting a 35 U.S.C. §102(b) rejection of these claims, and applicants respectfully request reconsideration and withdrawal of the rejections of claim 18 based on Ensley. Similarly, Ensley does not teach or suggest the limitations present in claims 19-20 when analyzed in light of pushing the line through a one-way locking passage housed in a sequentially interconnected retainer and attaching an attachment portion of the sequentially interconnected retainer to an end of a fish tape. Therefore, claim 18 and the claims that depend thereon are patentable over the cited art.

Regarding the 35 U.S.C. § 103(a) rejections, by law, in order to establish *prima facie* obviousness of a claimed invention, all of the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). In addition, "all words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). Further, if prior art, in any material respect teaches away from the claimed invention, the art cannot be used to support an obviousness rejection. *In re Geisler*, 116 F.3d 1465, 1471, 43 USPQ2d 1362, 1366 (Fed Cir. 1997).

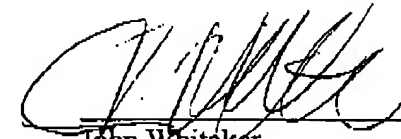
Turning to the rejection of dependent claims 4 of the present invention, the Office action rejected claim 4 under 35 U.S.C. § 103(a) as being unpatentable over Ensley. Applicants respectfully submit that the rejection of claim 4 is improper. Claim 4 depends from independent claim 1. For the reasons stated above with reference to claim 1, Ensley does not disclose, teach, or even suggest the limitation of claim 1. Furthermore, Ensley actually teaches away from the limitations of claim 1, and therefore, Ensley cannot reject claim 4 under 35 U.S.C. § 103(a).

In view of the foregoing, Applicant submits that independent claims 1 and dependent claims 2-13 which depend therefrom are in condition for allowance. For analogous reasons to those recited above in connection with independent claim 1, Applicant submits that independent claims 14 and 18, and dependent claims 15-17, and 19-20 which depend therefrom, respectively, are in condition for allowance.

CONCLUSION

Applicant respectfully requests a Notice of Allowance for the pending claims in the present application. If the Examiner is of the opinion that the present application is in condition for disposition other than allowance, the Examiner is respectfully requested to contact the undersigned at the telephone number listed below in order that the Examiner's concerns may be expeditiously addressed.

Respectfully submitted,



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